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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/022,149 | 12/14/2001 | Paul A. Flaherty | M-8631 US | 1681 |

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EXAMINER

ELISCA, PIERRE E

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3621

DATE MAILED: 07/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,149

Applicant(s)

FLAHERTY, PAUL A.

Examiner

Pierre E. Elisca

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-20 and 22-32 is/are rejected.
- 7) ☒ Claim(s) 5 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Regarding the status of the claims in the instant application, the Examiner has made an updated search and found new prior art. The Examiner is obliged to apply the newly found prior art. Thus, the finality of the prior office action has been withdrawn and a new rejection follows. The Examiner regrets the delayed process of the application.

Accordingly, claims 1-32 are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6-20 and 22-32 are rejected under 35 U.S.C. 102 (e) as being anticipated by Barnes, Jr. (US 2003/00665805 A1).

As per claims 1-4, 6 and 8-9 Barnes discloses a two way communication link for providing location based functions, and mobile e-commerce (which is readable as Applicant's claimed invention wherein said a communication application executable on a network), comprising:

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a client process executable on a processor in a two-way communication device, the two-way communication device (see., abstract, pages 3 and 4, [0044]);

a server process executable on a processor communicatively coupled over the network to the client process (see., abstract, pages 1-4); and

coupon depository or storage coupled to the server process capable of storing a plurality of particular coupons (see., page 23, [0237], page 25, [0255]);

a coupon depository coupled to the server process capable of storing a plurality of coupons, the coupons including an encoding of a barcode image, the server process including an operation of sending a particular coupon to the client process, the client process including an operation for decoding the respective barcode image encoding corresponding to the particular coupon and displaying the respective barcode image on the display screen (see., page 18, [0182], page 20, [0208], specifically wherein said the displayed information may be a barcode that is played on the device's display and which is read with a barcode code reader).

As per claim 7, Barnes discloses the claimed limitations wherein the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers (see., abstract, pages 3 and 4, [0044]).

As per claims 10-12, 14-20 and 22-32 Barnes discloses a two way communication link for providing location based functions, and mobile e-commerce (which is readable as

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Applicant's claimed invention wherein said a communication application executable on a network), comprising:

a client process executable on a processor in a two-way communication device, the two-way communication device (see., abstract, pages 3 and 4, [0044];

an interactive input process capable of receiving input signals from the two-way communication device (see., abstract, pages 3 and 4, [0044, page 18, [0182], page 20, [0208];

a communication initiating process responsive to the input signals for sending application initiation signals to the server process via the network (see., abstract, pages 3 and 4, [0044, page 18, [0182], page 20, [0208]; and

a communication receiving process responsive to communication signals from the process for receiving coupon information from the server process for receiving coupon information from the server process, the coupon information including an encoded barcode image; and a display process responsive to the receipt of the coupon information for decoding the encoded barcode image and displaying the barcode image (see., pages 3 and 4, [0044, page 18, [0182], page 20, [0208).

As per claims 13 and 22, Barnes discloses the claimed limitations wherein the two-way communication device is selected from among a group consisting of cellular telephones, pagers, and palm-held computers (see., abstract, pages 3 and 4, [0044).

Allowable Subject Matter

4. Claims 5 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pierre Eddy Elisca

Primary Patent Examiner

July 18, 2005